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10/725,987

12/02/2003

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05/28/2004

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EXAMINER

ESTRADA, ANGEL R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 05/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,987

Applicant(s)

ROESCH ET AL.

Examiner

Angel R. Estrada

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 14-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-12, 14 and 15 is/are allowed.
- 6) ☒ Claim(s) 16-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/8/04 & 3/11/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 16 and 17 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 4 and 5 of prior U.S. Patent No. 6,710,245. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nattel et al (US 5,354,953, hereinafter Nattel)

Regarding claim 18, Nattel discloses a gangable electrical unit (see figure 2) comprising a bracket (14) for housing an electrical component (see figure 1); said bracket (14) including a front surrounded by at least four walls; and an adhering element (column 3 lines 15-20, welding) attached to a first wall and positioned to engage a wall of an electrical outlet box (see figure 2).

Regarding claim 19, Nattel discloses the gangable electrical unit (see figure 2) wherein the adhering element (welding) is spaced from the front opening (see figure 2).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nattel et al (US 5,354,953, hereinafter Nattel) in view of Frye (US 4,942,071)

Regarding claim 20, Nattel discloses a gangable electrical unit (see figure 2) for positioning an electrical component beside an electrical outlet box comprising: a bracket (14) for housing an electrical component, said bracket including a front opening surrounded by a wall structure (see figure 2); but Nattel lacks a non permanent adhering element attached to the wall structure. Frye teaches a non-permanent adhesive holding device (10) for fastening a flat rigid surface of an object (such as the wall of Nattel's bracket, 14) to a flat wall (such as a junction box wall). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide to Nattel's bracket with a non permanent adhering element for connecting the bracket to a wall of an electrical outlet box as taught by Frye to improve the manufacturing process by eliminating Nattel's welding step and providing means that will allow removal of the bracket whenever is necessary.

Regarding claim 21, Frye teaches the adhering element being one of an adhesive, an adhesive tape, a putty, or a hook and loop tape (see figure 1)

Allowable Subject Matter

4. Claims 1-12, 14 and 15 are allowed.

The following is an examiner's statement of reasons for allowance: The primary reasons for the indication of the allowability of claims 1-12, 14 and 15 are:

Regarding claims 1-12, the prior art does not teach or fairly suggest in combination with the other claimed features a side wall having a leveling structure for *DR 5/25/04* leveling the bracket relative to an electrical outlet box; and an adhering element attached to the side wall of the bracket with the leveling structure being coupled between the side wall of the bracket and a wall of an electrical outlet box.

Regarding claims 14 and 15, the prior art does not teach or fairly suggest in combination with the other claimed features a second member coupled to the wall structure of the bracket along a weakened portion that is positioned between the second member and the wall structure, wherein the second member is configured to be broken away from the wall structure of the bracket with the application of a force sufficient to break the weakened portion.

These limitations were found in claims 1-12, 14 and 15, and are neither disclosed nor taught by the prior art of record, alone or in combination.

Conclusion

5. This application is a 2nd action non-final. The first action was premature because the preliminary amendment had not been received; Applicant filed a petition to suspense action for 2 months on January 23rd so the Patent Office shouldn't have acted on it until March 23rd. The first office action was mailed on March 3, 2004

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Jorgensen (US 4,428,492), Hass (US 1,929,844), Rohmer (US 6,508,445), Simmons (US 5,574,255) disclose a gangable electrical housing.


7. Any inquiry concerning this communication should be directed to Angel R. Estrada at telephone number (571) 272-1973. The Examiner can normally be reached on Monday-Friday (8:30 -5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (571) 272-2800 Ext: 31. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Angel R. Estrada

May 18, 2004

 5/25/04
DEAN A. REICHARD
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800